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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,624	08/28/2003	Vincent C. Skurdal	200309874-1	7729

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EXAMINER

RUSSELL, TRACI L

ART UNIT PAPER NUMBER

2136

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/21/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/650,624

Applicant(s)

SKURDAL ET AL.

Examiner

Traci L. Russell

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>08/28/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Pursuant to U.S.C. 131, claims 1- 26 have been examined.

#### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1,6,7,8,14, and 19 are rejected under 35 U.S.C. 101 because the claims are directed toward non-statutory subject matter. It appears the claims are directed towards functional descriptive material, per se, but fail to produce a useful, concrete, and tangible result. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5-6, 14-16, and 18-19 rejected under 35 U.S.C. 102(a) as being unpatentable by applicant admitted prior art ("AAPA").

- (1) with regard to claims 1, 14, and 25:

The AAPA teaches a method of operating an image processor comprising:

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printing a control document indicative of one or more watermarks ([paragraph 0002], lines 1-2); scanning the control document to detect a first user mark designative of one or more watermarks ([paragraph 0002], lines 3-7); and adding data corresponding to the selected one of the one or more watermarks to data corresponding to printed material to form data corresponding to watermarked material ([paragraph 0002], lines 7-9).

(2) with regard to claims 2 and 15:

The AAPA teaches printing the watermarked material ([paragraph 0001], lines 6-8).

(3) with regard to claims 3 and 16:

The AAPA teaches printing the watermark resulting from the detection of a second user mark corresponding to printing instructions in response to scanning the control document ([paragraph 0002], lines 9-11).

(4) with regard to claims 5 and 18:

The AAPA teaches displaying the watermarks on printed material according to display options as a result of the detection of one or more second marks corresponding to one or more display options in response to scanning the control document ([paragraph 0002], lines 11-13).

(5) with regard to claims 6 and 19:

The AAPA teaches adding data corresponding to the selected watermarks comprising receiving the data corresponding to the selected watermarks as a result of detecting the first user mark from removable memory ([paragraph 0002], lines 7-9).

In addition, computer-usable media and the use of a multifunction copier had to be used in order to perform the functions claimed. Therefore, for the reasons noted in the rejections, claims 1-3, 5-6, 14-16, 18-19, and 25 are not patentable.

4. Claims 1-9, 12-19, 21, and 25-26 are rejected under 102(b) as being unpatentable over Uchida (US 6,370,258). Uchida teaches an image processing apparatus and method for adding information to an input image so it cannot be easily detected by the human eye, i.e., watermark information (see Fig 3).

(1) in regards to claims 1 and 14: Uchida teaches a method comprising printing a control document indicative of one or more watermarks ('reference numeral 200'; Col 2, lines 29-33); scanning the control document to detect a mark designative of one or more watermarks ('image scanner section'; Col 2, lines 25-29); and adding data corresponding to one or more watermarked material ('section 1065'; Col 3, lines 44-49).

(2) in regards to claims 2 and 15: Uchida teaches a method comprising printing the watermarked material ('...generated and subjected to image processing in the image scanner section, 201 on a recording medium, such as printing paper'; Col 2, lines 29-33).

(3) in regards to claims 3 and 16: Uchida teaches the image data is putput to printer ('section 200'; Col 6, lines 9-23).

(4) in regards to claims 4 and 17: Uchida teaches sending data to one or more destination addresses (Col 6, lines 21-32).

(5) in regards to claims 5 and 18: Uchida teaches displaying watermark on printed material after scanning and detecting the watermark (Col 6, lines 9-23).

(6) in regards to claims 6 and 19: Uchida teaches receiving data upon detection of a mark from removable memory (Col 3, lines 52-59).

(7) in regard to claim 7: Uchida teaches a method wherein an image processor is in watermarking mode (Fig 3; Col 4, lines 19-25)

(8) in regard to claim 8: Uchida teaches a method wherein the mode is via indicator or activation of a selection key (Fig 4; Col 4, lines 34-45).

(9) in regard to claim 9: Uchida teaches a method wherein printing of a control document is in response to a user activating a print key of the image processor ('image is output to printer selection 200 and external apparatuses and the image data is printed to an external printer (Col 3, lines 52-59).

(10) in regard to claim 25: Uchida discloses a multifunction copier comprising a scanner(see '201' in Fig 1); digitizer connected to the scanner (Col 3, lines 12-14); a controller connected to the digitizer ('A/D converter, 102' in Fig 2); a printer connected to the controller('ref 200'; Col 2, lines 29-33). In addition, Uchida teaches a method comprising printing a control document indicative of one or more watermarks('reference numeral 200'; Col 2, lines 29-33); scanning the control document upon detecting a first user mark designative of one or more watermarks ('image scanner; Col 2, lines 25-29); converting the printed material into data corresponding to the printed material using the digitizer('analog signal processing circuit, 101'; Col 3, lines 10-16); adding data corresponding to the scanned material ('section 1065'; Col 3, lines 44-49); and printing the watermark material using the printer (Col 3, lines 51-58).

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5. Claims 10-11, 20, and 22-24 are rejected under 102(e) as being unpatentable over Monty, et al (US 6,956,671)

(1) in regard to claims 10, 20, and 23: Monty, et al teaches operating a multifunction copier comprising printing a watermark control document with one or more watermarks (Fig 3A; Col 6, lines 14-39); scanning the document to detect a mark that designates the thumbnail for selecting a watermark (Col 5, lines 63-65), Col 19, lines 2-9, and Col 19, lines 53-57; scanning the printed material 'step 504', Col 19, lines 9-12); adding the watermark to the printed material to form watermark material (Col 6, lines 2-5); and printing the watermark material 9Fig. 16; 'step 558'; Col 20, lines 12-19.

(2) in regard to claim 11: Monty, et al teaches before printing the watermark document, generating one or more thumbnail images from data stored in memory of the multifunction copier or removable memory connect to the copier (Col 13, lines 14-35).

(3) in regards to claim 12: Monty, et al teaches operating a multifunction copier. Monthly that comprises adding the watermark to the document held in memory (Figs 3A and 3E; 'select pictures for storage area, 66', which allows the user to designate whether images and watermarks are stored in memory of the printer or some other storage method; Col 17, lines 19-31).

(4) in regards to claims 13 and 21: Monty, et al teaches operating a multifunction copier that displays the watermark on printed material according to one or more display options ('user designation areas, 54'; Col 6, lines 40-66).

(5) in regard to claim 22 and 24: Monty, et al teaches adding one or more thumbnail images to an electronic version of the control document before printing the control document (Fig 16; 'step 560'; Col 20, lines 19-23).

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Russell whose telephone number is 571.272.1095. The examiner can normally be reached on Mon - Fri (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571 272.4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

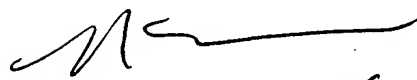


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